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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER	
[illegible]	
ART UNIT	PAPER NUMBER
[illegible]	

DATE MAILED: [illegible]

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/000366	Hoashi et al
Examiner	**Group Art Unit**
Drew Becker	1761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Peri d for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 3-1-99.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disp sition of Claims

☒ Claim(s) 1, 3-12 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 1, 3-12 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☒ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

Office Actl n Summary

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

> (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
>
> (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
>
> © In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

2. Claims 1 and 3-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "to a substantially uniform particle size" in claims 1 and 7 is not adequately supported by applicants' specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 3-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "to a substantially uniform particle size" in claims 1 and 7 is a relative term which renders the claims indefinite. The term "to a substantially uniform particle size" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unknown as to whether the above phrase refers to size or shape and to what degree.

6. Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is improper for "method of using" claims to be dependent on "method of making" claims, as claims 8-9 use the fish paste product made in claim 7. Claims 8-9 are considered improper hybrid claims and therefore claim 8 should be rewritten as an independent claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 3-7, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al in view of JP 60-70049.

Katoh et al teach the concepts of crushing and thawing frozen fish meats as a preliminary step (column 3, lines 31-37), milling into pieces of between 3.0 and 10 mm in size (column 7, line 4), mixing in additives with a mixer of the same type as that of the applicants' (column 7, line 10; Figure 1), and thawing (column 3, line 35). It would have been obvious to one of ordinary skill in the art to thaw the fish of Katoh et al without mashing since thawing by simply leaving a frozen product in a warmer environment is a commonly known method of thawing. Katoh et al do not explicitly teach the concept of first freezing followed by grinding of the fish meats and the grinding step comprising crushing followed by milling of the fish meats. JP 60-70049 teaches the concept of grinding already frozen fish meats into particles (claim)by use of a cutter (page 3, lines 24-30). It would have been obvious to one of ordinary skill in the art to incorporate the freezing then milling method of JP 60-70049 into the method of Katoh et al since Katoh et al already include the steps of crushing and freezing but not explicitly in the order of JP 60-70049 and thawing after size reduction takes less time because the decreased thickness of the fish aids conductive heat transfer. It would have been obvious to one of ordinary skill in the art to combine

the cutter of JP 60-70049 with the uniform milling of Katoh et al since a more gradual size reduction process by use of a cutter, as disclosed by the applicants (page 5, line 20), would be beneficial to the service life of the milling machinery.

9. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al and JP 60-70049 in view of JP 06-133739.

Katoh et al and JP 60-70049 teach the concepts mentioned above. Katoh et al also teach the concepts of producing kamaboko by molding the ground fish (column 6, line 52), heating the ground fish while in the mold for network formation (column 6, line 60), and further heating (column 6, line 62). Katoh et al and JP 60-70049 do not teach the concept of heating the fish paste by passing electric current through the fish. JP 06-133739 teaches the concept of heating fish by passing electric current through it (Constitution). It would have been obvious to one of ordinary skill in the art to incorporate the electric heating of JP 06-133739 into the method of Katoh et al and JP 60-70049 since ohmic heating is a commonly known method of heating and does not require a heating medium, such as oil or steam, to contact the food.

Response to Arguments

10. Applicant's arguments filed March 1, 1999 have been fully considered but they are not persuasive.

In response to applicant's argument that Katoh et al, JP 60-70049, and JP 61-33739 are not capable of being combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is

it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Katoh et al teach a method of uniformly milling ground fish prior to mixing and making kamaboko (column 7, lines 3-23), JP 60-70049 teach shearing and grinding frozen ground fish prior to thawing (page 1, claim; page 3, lines 20-24), and JP 06-133739 teach a method of heating fish (constitution) which taken as a whole teach that frozen ground fish can be milled before thawing. It would have been obvious to one of ordinary skill in the art to incorporate the grinding of frozen ground fish meat in the manner of JP 60-70049 into the method of Katoh et al since JP 60-70049 teach the advantage of a higher deformation ratio and excellent tasting touch when grinding unthawed frozen ground fish meat (page 3, lines 20-24).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew Becker whose telephone number is (703) 305-0300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The fax phone number for this Group is (703)-305-3601 .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

David Lacey
Supervisory Patent Examiner
Technology Center 1700

3/10/99

Drew Becker

March 10, 1999